



Modified PTO/SB/33 (10-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number

Q77964

Mail Stop AF
Commissioner for Patents
P.O. Box 1450 Alexandria, VA 22313-1450

Application Number

10/684,688

Filed

October 15, 2003

First Named Inventor

ATSUKI KASASHIMA

Art Unit

3711

Examiner

Alvin A. HUNTER

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal

The review is requested for the reasons(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

☒ I am an attorney or agent of record.

Registration number 55,154

Signature

David P. Emery

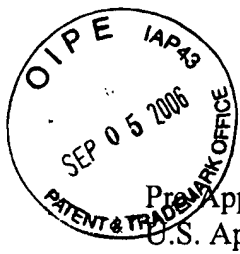
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Pre-Appeal Brief Request for Review
U.S. Appln. No. 10/684,688

Atty. Dkt. No. 77964

PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of

Docket No: Q77964

ATSUKI KASASHIMA

Appln. No.: 10/684,688

Group Art Unit: 3711

Confirmation No.: 3405

Examiner: Alvin A. HUNTER

Filed: October 15, 2003

For: GOLF BALL

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MAIL STOP AF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Pursuant to the new Pre-Appeal Brief Conference Pilot Program, and further to the Examiner's Final Office Action dated April 5, 2006, Applicant files this Pre-Appeal Brief Request for Review. This Request is also accompanied by the filing of a Notice of Appeal.

Applicant traverses the rejections of claims 1-21 for the reasons set forth below.

Claim Rejection - 35 U.S.C § 102(e)

The Examiner rejected claims 1-4, 6-8, 11, 12, 14, 17, 18 and 19 as being anticipated by Sullivan (US 6,884,183). Applicant submits that this rejection is in error because Sullivan (US 6,884,183) fails to disclose "a plurality of flat surface regions formed on the outermost spherical surface," as recited in claim 1.

In the Advisory Action of July 31, 2006, the Examiner disagrees with Applicant's assertion that Sullivan does not teach flat regions on the outermost surface of the golf ball stating:

If not mistake[n] a golf ball is suppose[d] to be spherical such as the golf ball in which the applicant's dimple pattern is shown to be on. "Spherical" does not imply that the golf ball must be shaped exactly circular.

(Advisory Action of July 31, 2006). Additionally, the Examiner provides an annotated FIG. 3A with a tangent line constructed "to the side surface of one of the dimples." (Advisory Action, p. 2). Further, the Examiner states that as shown by the drawing, the line is parallel to the surface of the outer portions of the dimples. Then, the Examiner somehow reasons that this can only indicate that the surface had to be milled in such a fashion that it is flat before placing the additional dimples within it. Based on this reasoning, the Examiner concludes that this is evidence enough that the dimples comprise flat regions.

In contrast, Applicant submits that the Examiner has misread the reference. First, no portion of Sullivan indicates that the golf ball is milled as alleged in the Office Action. Rather, the golf ball may be molded. Thus, the reasoning applied by the Examiner within the Advisory Action of July 31, 2006, is unsupported. In a related statement in the Office Action of April 5, 2006, the Examiner also presumes that the polygon dimples were formed in flat regions first before contouring with the dimples. (Office Action of April 5, 2006, p. 8) This statement is also unsupported by Sullivan.

Second, the statement that the dimples comprise flat regions is also unsupported. Sullivan discloses that conventional dimples are circular depressions that slope away from the outer surface of the ball to form the depression. (col. 1, lines 16-19). Furthermore, Sullivan discloses that its dimples differ from the conventional dimples as they are polygonal dimples.

Thus, as the dimple is disclosed as a depression, there is no support within Sullivan that the dimples comprise flat regions. In any event, as a depression, the dimple of Sullivan cannot comprise a flat surface region on the outermost surface of the golf ball.

Third, Sullivan fails to disclose any flat surface regions formed on the outermost spherical surface and, further, the existence of any flat surface regions is not inherent within the reference's disclosure. As expressly disclosed by Sullivan, the golf ball 10 comprises a plurality of dimples 12 separated by outer un-dimpled or land surfaces. Because the dimples are depressions they cannot comprise a flat surface region on the outermost surface of the golf ball, the land surfaces must be flat for Sullivan to anticipate claim 1.

As illustrated by each of FIGS 3A and 3B, the land surfaces include both inter-sectional spacings 22 and inter-dimple spacings 20. The Examiner seems to allege that these must somehow comprise flat surface regions. But, based on the Sullivan's disclosure, this position is wholly unsupported.

First, Sullivan discloses that the outer surface is substantially spherical. (col. 3, line 4). Absent is any support for any flat regions on the outermost surface. Assuming, *arguendo*, that the Examiner would take the position that substantially spherical description indicates that the outer surface is not perfectly spherical and, thus, flat regions are inherent, Applicant submits that because flat regions are not necessarily present, this would not be a proper anticipation rejection. (*See Continental Can Co. USA v. Monsanto Co.*, 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). For example, the presence of dimples may themselves provide an outer surface that is not perfectly spherical.

Second, FIGS. 3A, 3B4 and 5 provide no support for the Examiner's position that the inter-sectional spacings 22 and the inter-dimple spacings 20 include any flat regions. The Examiner attempts to show in the Advisory Action that FIG. 3A indicates a flat region.

However, the outer portions of this figure merely indicate edge portions of the dimples as the dimple pattern that is repeated throughout the ball has not been completed at the edge of the figure. This outer edge surface is actually the upper portion of the hollow of a dimple. In other words, there is no support that this outer edge portion of the figure represents any of the inter-sectional or inter-dimple spacings 20 and 22. Moreover, the inter-sectional spacings 22 and the inter-dimple spacings 20 are clearly illustrated running across the figures and clearly appear to be continuous. If Sullivan is to disclose via the figures that the spacings comprise flat regions, the figures must illustrate a line where adjoining flat surfaces meet. Specifically, if the golf ball is substantially spherical and the spacings contain flat regions as alleged, then there must be some angular intersection between flat regions if they are to reside on the spherical surface. However, no such indication exists in any of the figures of Sullivan. Thus, the figures only support that both the inter-sectional spacings 22 and the inter-dimple spacings 20 run continuously around the circumference of the golf ball without any flat regions.

Therefore, Applicant submits that claim 1 is allowable for at least this reason. Additionally, Applicant submits that because this same feature is recited in claims 8, 13 and 14, these claims are allowable for the same reasons set forth above. Furthermore, Applicant submits that claims 3-4, 6-7, 11-12 and 18-19 are allowable, at least because of their dependency.

35 U.S.C. § 103(a) Rejection - Claims 5, 9, 10 and 13

Claims 5, 9, 10 and 13 stand rejected under Sullivan in view of an obvious design choice. The Examiner concedes that Sullivan does not disclose the number of dimples recited in these claims. In order to compensate for this deficiency, the Examiner states that it would have been obvious for one of ordinary skill in the art to have this number of dimples to reduce the land area of the golf ball.

However, despite this alleged modification proposed by the Examiner, the combination fails to compensate for the above noted deficiency of Sullivan. Thus, Applicant submits that claims 5, 9, 10 and 13 are allowable, at least because of their dependency.

35 U.S.C. § 103(a) Rejection - Claims 20 and 21

Claims 20 and 21 have been rejected as being unpatentable over Sullivan in view of U.S. Patent No. 5,566,943 to Boehm. The Examiner concedes that Sullivan does not disclose the dimple having a bottom parallel to the surface region. To compensate for this deficiency, the Examiner applies Boehm. However, because Boehm fails to compensate for the deficiency noted above with regard to independent claims 1, 8, 13, 14 and 17, Applicant submits that dependent claims 20 and 21 are allowable, at least, because of their dependency.

In view of the above, reconsideration and allowance of this application are now believed to be in order.

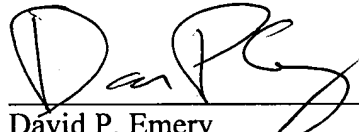
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Respectfully submitted,



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Date: September 5, 2006